

REMARKS

Claims 37-58 are pending in the present application. Claims 55-57 have been withdrawn from consideration. Claims 37-54 and 58 have been rejected. No claims have been allowed. No claims have been canceled, amended, or added.

I. Results of Examiner Interview

Applicants respectfully request clarification regarding the rejections of the present Office Action in light of the telephonic interview of March 11, 2004, between Examiner Enatsky and the undersigned attorney. The substance of this telephonic interview included an admission that the proposed and now pending claims would be allowable over the prior art of record at the time if these claims were submitted in an RCE, which was then done. This requirement to file an RCE before these claims would be considered was made due to the fact that further prior art searching would be required. These relevant interview highlights were summarized in both the March 16 Interview Summary by the Examiner and the Response to Office Action filed with the RCE by Applicants. Accordingly, Applicants respectfully request clarification of the present rejections of these claims over only the prior art of record in light of this previous interview.

II. Restriction and Withdrawal of New Claims

Recently submitted new claims 55-57 were withdrawn from consideration as being directed to an invention that is independent or distinct from the invention originally claimed. The full basis given in the Office Action is that these claims "are directed to a method of code authentication where code is transmitted multiple times between a game machine controller and a peripheral device, then compared at a game machine controller for authentication purposes." Applicants respectfully traverse this restriction and withdrawal of claims.

Applicants initially note that withdrawn independent claim 55, from which withdrawn claims 56 and 57 depend, is substantially similar in nature to a hypothetical combination of claims 43 and 45. In particular, claim 43 recites, "authenticating said new operating code," while claim 45 recites, "periodically verifying said new operating code . . . including transmitting said new operating code from said peripheral device to said gaming machine controller for comparison." These elements appear to be substantially relevant to the exact basis for restriction and withdrawal of claims 55-57. Applicants also note that claims 43 and 45 have already been examined at least three times during the prosecution of this application. Applicants respectfully submit that the restriction and withdrawal of claims 55-57 is thus improper in light of the substantial similarity to previously examined claims, and also in light of the lack of apparent need for any further prior art searching or any other undue burden in the examination of these claims. Accordingly, Applicants respectfully request that these claims be appropriately reinstated and examined.

III. Rejection under 35 U.S.C. § 112

Claim 51 stands rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In particular, an incorrect assumption appears to have been made that this claim, "require[s] that a gaming machine does not need to physically access a peripheral device." Applicants respectfully submit that this is not the case.

Applicants first point to the statement in the previously filed Response that "Support for new claims 51 and 57 can be found at, for example, page 31 lines 4-6 of the specification as originally filed." As will be readily appreciated through a combined consideration of the context of this statement in the specification, the problems solved by the more automated features provided in the present invention, and the advantages gained by such features in the

present invention, the relevant claim element "without needing to physically access said peripheral device" does not refer to a gaming machine. Rather, this claim element refers to service personnel or any other party or entity that might ordinarily be required to access the peripheral device physically or manually to provide the device with the new operating code, as claimed. Applicants thus submit that the meaning of this claim element can be determined from its context and also by way of reference to the written description, and that any possible ambiguity with respect to this claim element has been resolved through the remarks presented herein in any event. Accordingly, Applicants respectfully submit that the § 112, second paragraph, rejection has hereby been obviated.

IV. Rejections under 35 U.S.C. § 103

Each of claims 37-54 and 58 stands rejected under 35 U.S.C. § 103(a). Claims 37-40, 42, 44, 46-49, 50-54 and 58 stand rejected as being unpatentable over U.S. Patent No. 6,263,392 to McCauley ("McCauley") in view of Request For Comments: 951 by Croft et al. ("Croft"). Claim 41 stands rejected as being unpatentable over McCauley in view of Croft, and further in view of U.S. Patent No. 6,052,779 to Jackson et al. ("Jackson"). Claims 43 and 45 stand rejected as being unpatentable over McCauley in view of Croft, and further in view of U.S. Patent No. 5,802,592 to Chess et al. ("Chess"). In particular, the Office Action states, "Other well-known reasons behind remote bootstrapping is efficient software updating without requiring manual software updating on every peripheral device in use." Applicants respectfully traverse these rejections.

To establish a *prima facie* case of obviousness, a proffered combination of prior art references must teach or suggest *all* claim limitations. See, e.g., MPEP § 2143. In addition, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify a reference or

combine reference teachings. *See id.* Applicants respectfully submit that neither of these requirements is met by the obviousness rejections as set forth in the Office Action, such that a *prima facie* case of obviousness has not been established. Applicants also submit that in the event that a *prima facie* case of obviousness does become established, other factors and/or secondary considerations that serve to rebut such obviousness rejections can be provided.

No Gaming Machine in Prior Art

In order to render a claim as obvious, a purported combination of references must contain every material element of that claim. Each of independent claims 37, 46, 55 and 58 recites a "*gaming machine adapted [to play / for presenting] a game for a player once a bet has been placed and to pay a winning to the player for at least one particular predetermined outcome of the game.*" All other pending claims depend from one of these four independent claims, such that every pending claim contains this element. As was done in the previous Response to Office Action, Applicants again respectfully submit that none of McCauley, Croft, Jackson or Chess discloses "a gaming machine adapted to play a game for a player once a bet has been placed and to pay a winning to the player for at least one particular predetermined outcome of the game."

Despite the Office Action assertion that "McCauley teaches peripheral devices in a PC game machine," Applicants respectfully submit that such a "PC game machine" or arcade game is not a "gaming machine adapted to play a game for a player once a bet has been placed and to pay a winning to the player for at least one particular predetermined outcome of the game." In fact, the gaming machine that is the subject of the pending claims is well known in the art as a machine adapted to play and pay out for wager based games, and is also well known in the art to have substantial differences with respect to a "PC game machine" or other PC device. Applicants point to and incorporate by reference the examples made in support of this fact from the previous Response to Office Action. Because none of the recited

prior art references discloses such a gaming machine, Applicants respectfully submit that the pending § 103 rejections for all pending claims cannot stand for at least this reason.

In addition, Applicants note that several of the pending dependent claims similarly contain additional elements that have not been properly accounted for in the recited prior art. For example, the Office Action states, "In regard to claim 50, McCauley teaches game machine (Fig. 2, ref. 4) controls peripheral devices (Fig. 2, ref. 40, 42, 44, 46), which would be considered a master controller." Conversely, pending claim 50 actually recites, "wherein said gaming machine controller comprises a *master gaming controller*" (emphasis added). Applicants first reiterate that McCauley does not disclose a gaming machine (i.e., slot machine, video poker or keno machine, etc.), and also point out that a "master gaming controller" is a precise term of art used in the gaming machine industry to denote the primary CPU or processor of a gaming machine. Such a master gaming controller is known in the art as being the unit that is responsible for the overall administration and performance of a gaming machine, and is a highly regulated component that must meet many regulatory requirements. Quite simply, item 4 of McCauley is not a master gaming controller.

As another example, the Office Action states, "In regard to claim 52, McCauley teaches that the system can have multiple peripheral devices of the same type (Fig. 2) or a variety of different devices (6:23-34)." Conversely, pending claim 52 actually recites, "wherein said gaming machine comprises a plurality of peripheral devices *configured as download devices*" (emphasis added). Applicants again note that McCauley does not disclose a gaming machine, and further submit that McCauley also does not disclose a plurality of peripheral devices configured as download devices. In another example, claim 43 recites, "authenticating said new operating code before transmitting said new operating code to said peripheral device." Although the Office Action states, "Chess teaches . . . authenticating control code during the bootstrapping process," this is not the same as "authenticating new

operating code *before* transmitting the new operating code to a peripheral device.”

Applicants respectfully submit that Chess does not teach such an operation.

In another example, claim 45 recites, “verifying said *new operating code* transmitted to said peripheral device, *including transmitting said new operating code from said peripheral device to said gaming machine controller for comparison to the new operating code originally transmitted to said peripheral device*” (emphases added). Although the Office Action states, “Chess also teaches regularly verifying authenticity of the control code contents,” this fails to account for several claim limitations, such as those for “new operating code,” “transmitting . . . from said peripheral device to said gaming machine controller” and “comparison to the new operating code *originally transmitted* to said peripheral device.”

Applicants submit that Chess does not disclose verifying new operating code, does not disclose transmission of such code from a peripheral device to a gaming machine controller, and does not disclose that the comparison is made to the new code as originally transmitted. Rather, Chess discloses, “performing, when called, a signature computation on the current contents of [an] alterable ROM 116 and the current signature (stored in [unalterable] ROM 114 or elsewhere).” This is simply not the same as that which is being claimed in claim 45.

No New Operating Code in Prior Art

Referring once again to all claims, each of independent claims 37, 46, 55 and 58 recites, “*new operating code adapted to [control / enable] the [complete] operation of said peripheral device and containing a least a portion of [operating] code that is different from any operating code previously used by said peripheral device.*” Again, all other claims depend from one of these four independent claims, such that every pending claim contains this element. As was also done in the previous Response to Office Action, Applicants again respectfully submit that none of the recited prior art references discloses “new operating code

adapted to control the operation of said peripheral device and containing a least a portion of code that is different from any operating code previously used by said peripheral device.”

Rather than point to any part of any recited prior art reference that teaches such an element, however, the Office Action simply states, “Other well-known reasons behind remote bootstrapping is efficient software updating without requiring manual software updating on every peripheral device in use.” Applicants respectfully submit that this is an entirely inappropriate basis for meeting the requirement that a proffered combination of prior art references must teach or suggest *all* claim limitations to establish a *prima facie* case of obviousness (MPEP § 2143). Because none of the recited prior art references have been shown to disclose such a provision for new operating code in the manner that is presently claimed, Applicants respectfully submit that the § 103 rejections for all pending claims cannot stand for at least this separate reason as well.

No Proper Motivations to Modify or Combine References

The teaching or suggestion to make a claimed combination or modification must be found in the prior art, and not based upon the disclosure of the Applicant. *See* MPEP § 2143. In addition, the level of skill in the art cannot be relied upon to provide the suggestion to combine or modify references, and the mere fact that references can possibly be combined or modified does not render the resultant combination or modification obvious unless the prior art also suggests the desirability of such a change. *See* MPEP § 2143.01.

As was similarly done in the previous Response to Office Action, Applicants again respectfully submit that proper motivations to modify and combine the prior art references in the manner that has been done in the Office Action have not been provided. As noted above, none of the recited prior art references discloses “new operating code adapted to control the operation of [a] peripheral device and containing a least a portion of code that is different from any operating code previously used by said peripheral device.” To compensate for this

collective failure of the recited prior art to disclose such an element, the Office Action simply asserts, "Other well-known reasons behind remote bootstrapping is efficient software updating without requiring manual software updating on every peripheral device in use." The Office Action then appears to reflect an assumption that this missing element has been readily incorporated into Croft without ever even stating as much. Of course, such an unstated assumption clearly fails to account for any proper motivation from *within the prior art itself* for making such a proposed modification of Croft. Applicants thus respectfully submit that the § 103 rejections for all pending claims cannot stand for at least this reason as well.

In addition, Applicants again submit that McCauley, Croft, Jackson, Chess and all other references that have been cited as pertinent prior art are all non-analogous art with respect to the gaming machine industry. In particular, none of these references disclose the material elements of a *gaming machine* and a gaming machine peripheral device adapted to accept *new operating code* in the manner prescribed by the present claims. Accordingly, it is inappropriate to use such non-analogous references in combination to render as obvious the presently claimed invention, particularly where these references are collectively inadequate with respect to disclosing a *gaming machine* having a peripheral device adapted to accept *new operating code* as required by the present claims. Applicants again respectfully submit that prior art references regarding non-analogous art that do not deal with gaming machines and problems associated with gaming machines are inherently not references that one of ordinary skill in the gaming machine arts would use to solve problems associated with gaming machines. Accordingly, any simple addition to the recited prior art of a true gaming machine reference that does not teach or suggest these features would similarly result in an improper combination of references that has been made without respect to the proper motivations to combine being taught by those references themselves. In any event,

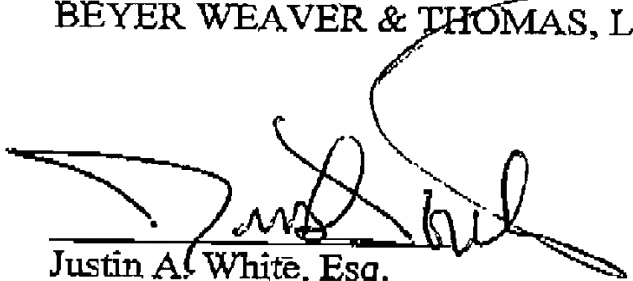
Applicants respectfully submit that a proper motivation to combine the recited prior art references in a manner so as to solve a *gaming machine* related problem has not been shown.

CONCLUSION

Applicants respectfully submit that all claims are in proper form and condition for patentability, and request a Notification of Allowance to that effect. It is believed that no fee is due at this time. Should any fee or fees be required for any reason related to this document or application, however, then the Commissioner is hereby authorized to charge such fee or fees to Deposit Account No. 50-0388, referencing Docket No. IGT1P118. The Examiner is respectfully requested to contact the undersigned attorney at the telephone number listed below with any questions or concerns relating to this document or application.

Respectfully Submitted,
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